

REMARKS

Claims 52-86 are currently pending in the application. Applicants have canceled claims 1-51 and 55-60, have amended claims 52-54, and have added new claims 61-86. Applicants request reconsideration of the application in light of the following remarks.

In-Person Interview

Applicants' attorney wishes to thank the Examiner for her courtesy and time during a in-person interview that was held on March 3, 2003 at which time agreement was reached with respect to the art and allowability of the amended and proposed new claims generally. The Examiner's comments and insight were very helpful in preparing this response. It is hoped that the comments below reflect the spirit of the interview. The Examiner Interview Summary Record is enclosed herewith at the Examiner's request.

Rejections under 35 U.S.C. §112

Claims 1, 2, 5-29, 42, 43 and 45-54 stand rejected by the Examiner under 35 U.S.C. 112. In accordance with this rejection, Applicants have canceled claims 1, 2, 5-29, 42, 43 and 45-51 and restated the inventions in new claims 61-86 for clarification purposes in response to the indefiniteness rejection of the most recent Office Action. Applicants have amended claims 52-54 to comply with the examiner's suggestions and are now believed to conform with Section 112. Applicants respectfully request that the rejection of claims 52-54 under 35 U.S.C. § 112 be withdrawn.

Terminal Disclaimer

In light of the cancellation of claims 1, 2 and 5-28, Applicants hereby withdraw the previously submitted terminal disclaimer filed September 23, 2002 and respectfully request that it be removed from the file for being no longer necessary.

Rejections under 35 U.S.C. §102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 42, 43 and 45-54 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kim or Hoekstra et al. Claims 42, 43 and 45-51 have been canceled for clarity. Applicants again respectfully traverse this rejection with respect to claims 42-54 and request reconsideration of the claims.

Both the disclosures of Kim and Hoekstra describe machinery for automatically measuring and dispensing appropriate tint amounts for coloring paint. See Kim Abstract and Hoekstra, Abstract and col. 1, lines 6-15. Neither Kim nor Hoekstra discloses, expressly or inherently, every element of independent claim 52. The following are numerous examples of independent elements, each not found in either Kim or Hoekstra, but recited in claim 52. Each of these alone make claim 52 allowable over each of these references:

prompting a user to select through the apparatus whether the paint to be produced will have characteristics of either interior or exterior paint.

prompting the user to select through the apparatus a paint sheen.

prompting the user to select through the apparatus a paint color type.

prompting the user to place an empty can or bucket into the apparatus.

agitating the can or bucket to mix the at least two premixed aqueous compositions to produce the paint composition having the selected sheen, the selected color type and being well suited for either interior or exterior use as input by the user.

For both Kim and Hoekstra, the user is selecting only the paint color, and a full can of paint is being placed into the apparatus. Neither Kim nor Hoekstra discloses a system that prompts the user to select a paint sheen, a paint color type, or even whether the paint should have interior or exterior characteristics. In Applicants' invention of claim 52, an empty can or bucket is placed into the apparatus, the user selects the characteristics for the paint to be produced

(interior/exterior paint, high gloss/flat/satin/etc. paint, etc.), and non-paint premixed aqueous compositions are mixed by the machine to produce paint having the characteristics selected by the user. This process and ability to produce paint having any characteristic on demand using a common machine is not found in the art. More particularly, neither Kim nor Hoekstra discloses every element (or even most of the elements of) independent claim 52. Accordingly, independent claim 52 is allowable over both Kim and Hoekstra.

Dependent claims 53 and 54 are allowable over both Kim and Hoekstra, among other reasons, for depending from allowable claim 52. Specifically, neither Kim nor Hoekstra discloses prompting a user to select a paint quality through the apparatus and have the apparatus produce a paint having that quality, as recited by claim 53. Additionally, neither Kim nor Hoekstra discloses adding a premixed pigment composition into an empty can or bucket first and then adding other components to produce a paint composition at a location for selling paint as recited by claim 54. Accordingly, both claims 53 and 54 are independently allowable over both Kim and Hoekstra.

Applicants respectfully request that the anticipation rejections of claims 52-54 be withdrawn.

Rejections under 35 U.S.C. §103

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

Claims

Claims 1, 2, 5-29, 42, 43 and 45-54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bauer. Claims 42, 43 and 45-51 have been canceled for clarity. Applicants again respectfully traverse this rejection with respect to claims 52-54 and request reconsideration of the claims.

Bauer discloses a conventional method for making pigment slurry wherein a specific predetermined recipe is prepared for the pigment slurry. The slurry components are mixed to create a slurry pigment for later use as paint. There is no teaching or suggestion in Bauer, however, to make obvious any of a number of the elements of claim 52. For example, the process in Bauer involves a pre-set recipe for the predetermined pigment slurry to be made manually. There is nothing in Bauer that prompts a user to select any characteristic of the paint that will be automatically produced by the apparatus based upon the selection. For example, Bauer does not teach or suggest that an apparatus could exist which prompts a user to select any of a paint sheen, a paint color type, or even an interior/exterior paint characteristic. While a particular pigment slurry recipe will most likely result in a paint having perhaps particular paint color base type, any apparatus described in Bauer could not receive selections from the user and automatically produce paint having even the selected pigment slurry characteristics. The apparatus would necessarily be limited to producing a pigment slurry having only the characteristics of the pigment slurry produced by the recipe components the user placed in it.

Because of the process taught and suggested in Bauer, it would also not have been obvious to automate this process to a point where a user could select a list of particular paint characteristics and automatically generate a can or bucket of paint having those characteristics. Conventional paint making processes are very specific to the characteristics of the paint being produced in that batch and, until Applicants' invention, have not been controllable to the degree accomplished by Applicants' invention.

Bauer does not teach or suggest all of the elements of claims 52 and, therefore, does not anticipate claim 52. Dependent claims 53 and 54 are allowable over Bauer, among other reasons, for depending from allowable claim 52. Additionally, claim 53 is independently allowable over Bauer because Bauer does not teach or suggest prompting a user to select a paint quality through the apparatus and produce a paint composition based upon that selection. Claim

54 is independently allowable over Bauer, among other reasons, for reciting “depositing at least two premixed aqueous compositions into the can or bucket . . . at a location for selling paint.” As explained earlier, prior to Applicants’ invention, paint could not be automatically produced at the location for selling paint which has characteristics selected by a user of an apparatus.

Applicants respectfully request that the obviousness rejections of claims 52-54 be withdrawn.

Applicants’ Response to the Examiner’s “Response to Arguments”

On page 6 of the most recent Office Action, several points are raised which must be addressed herein with regard to the novelty of the invention and claims. Applicants specifically addressed this novelty with the Examiner in the in-person interview to overcome this rejection, and have provided additional evidence in support of the patentability of these claims and the invention in general.

First, Applicant’s claimed invention involves actually making the paint itself, not merely tinting existing paint, and second, the process is not merely the same process as is done in a conventional paint factory. In a conventional process in a paint factory, solvents, dispersants, surfactants, and defoamers (typically liquids) are placed into a mill, such as a high-speed disperser, according to a set formula for a paint to be made in that factory machine. The liquids are blended together to make a homogeneous mixture. Dry pigments are then added slowly to this mixture while the disperser is running at low speed until they are mixed into the liquid phase. The mill is then run at a high speed to shear the mixture and disperse the dry pigments to the desired particle size. The Quality Control Laboratory tests the quality of the pigment dispersion. Upon approval of the pigment dispersion (typically referred to as the “grind” in the paint industry), the “let down” process begins. One or more resins are added to the pigment dispersion depending on the desired product type and quality level. Other liquid or dry additives are charged that yield properties such as proper film formation, open time, gloss, wetting, and many others. Finally, thickening agents are added to give the final desired application characteristics.

Because this process is different for each paint quality, sheen, color base type, and exterior/interior characteristic combination of paint produced, and because the process is time consuming, involves numerous consecutive steps and people, each machine is conventionally set up to produce one type of paint. The produced paint is placed in a quart, one gallon, two gallon can or 5 gallon bucket and shipped to a retail store. At the retail store, such as Home Depot, a customer selects a can of paint off the shelf that holds paint having the color base type, sheen, quality and exterior/interior characteristics needed by the customer. The customer may also request that a colorant be added to the paint in the can.

Because conventional paint is made at the factory and cannot practically be made at the store, the retail store is required to store massive inventories of paint cans in anticipation of customers needing paint with particular characteristic combinations. If too many cans of one characteristic combination is ordered, it may go to waste. While the paint cans are waiting to be purchased, they fill floor space that could have been used by other paints or products, and cost money to keep in the store. Sales may also be lost because not enough of cans holding paint of one particular paint characteristic combination is available from the premixed paint cans in the store.

On the contrary, the inventions disclosed in the present application, because of the particular and unique combination of materials not previously mixed in this way before, allow for a homogeneous pre-mixture of components into an aqueous solution that remains stable and does not settle out over time. Furthermore, Applicants have determined specific combinations of these premixed aqueous solutions that enable a user to consistently create paint from the premixed aqueous solutions based upon a user's selection of any combination of paint characteristics (the full line of a paint manufacturer (wide variety of sheens, color base types, qualities, etc.)). Different quantities of the set of premixed aqueous components are used to create paint having each combination of paint characteristics. This removes a retailer's need for an inventory of unneeded paints and the guesswork in anticipating what customers will buy. It also reduces the work in moving the paint cans (which may happen 7 or more times before the can is sold), and the floor space required to display the cans. Customers can go to the paint counter of the store and request the desired paint characteristics and walk out with the paint made-to-order within minutes.

While the final paint quality and characteristics of conventional paint and paint produced by Applicants' methods and apparatus are comparable, Applicants produce the paint in a significantly different way which was not performed in or obvious from the art previously. Applicants' processes provide significant advantages for customers and retailers alike. The industry response to the new process is phenomenal and clearly shows the long felt need for the invention and the distinctiveness of Applicants' inventions from everything used in the art.

In response to the Examiner's request that the DVD be submitted with this response as evidence in further support of the state of the art and need in the industry for the invention generally, Applicants have attached hereto as Exhibit 1, a marketing DVD from MicroBlend Technologies. As explained to the Examiner during the interview of March 3, 2003 interview, the DVD is a marketing tool used to generally convey an abbreviated history of conventional paint making with the difficulties of the industry created by conventional processes, the general workings of the invention, and general responses of the paint industry to the invention. We believe this supports the long felt need for the ability to consistently manufacture paint of such wide characteristics variety on demand in a retail store. The DVD includes uncompensated endorsements from many respected persons in the paint industry from manufacturing to retail sales to professional painters. It should be clear, however, that these endorsements are not sworn statements and are submitted only as general statements of prior art. Additionally, Applicants have attached hereto as Exhibit 2, a sworn Declaration from Bob Smiland, CEO of Smiland Paint Company declaring the previously unrecognizable advantages and benefits of Applicants' system to the paint industry. If additional sworn testimony is helpful, Applicants will be glad to provide it at the Examiner's request to whatever extent possible.

Last, recalibrating the scale, as performed by particular embodiments of Applicants' invention, after each component is placed in the paint can is not done "to make sure the scale works" as proposed by the Examiner. No operator would practically recalibrate a scale subsequent to each partial use of the scale. Contrarily, the recalibration of the scale in Applicants' claims allows more accurate weight measurements to ensure that a correct amount of each component is added to make the correct paint. In a particular embodiment, for example, the scale is zeroed before each component is added so that only the weight of that newly added component is measured. To Applicants' knowledge, this method has not been used to determine the quantities of components to put into a mix of paint. In a practical sense, this method would

not have been used for paint production in the past because the prior art makes paint on such a large scale by volumes in large machines rather than by weights in small cans or buckets.

In summary, none of the references cited by the Examiner nor any other known prior art, either alone or in combination, disclose the unique combination of features disclosed in Applicant's claims presently on file. For this reason, allowance of all of Applicants' claims is respectfully solicited.

Regarding Doctrine of Equivalents

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

CONCLUSION


If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response.

Claims 52-54 and 61-86 are believed to be in condition for allowance and early notice thereof is respectfully solicited.

Should the Examiner determine that additional issues remain which can be resolved by a telephone conference or which would in any way advance prosecution of the case, the examiner is invited to telephone Applicants' undersigned attorney.

Respectfully submitted,

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